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|---|-------------|----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/643,989 | 08/20/2003 | Pi-Chang Lo | | 5148 |
| 7590 | 03/22/2006 | | EXAMINER | |
| M.K. Meditech Co., Ltd. P.O. Box No. 6-57 Junghe, Taipei, 235 TAIWAN | | | DESAUTO, MATTHEW F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3763 | |

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/643,989 | LO, PI-CHANG | |
| | Examiner Matthew F. DeSanto | Art Unit 3763 | |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/993,572, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior application fails to show support for the protruding portion (42) at a front end of the engagement section of the instant application. Therefore, claims 1-3 are not entitled to the benefit of the prior application and the effective filing date is 8/20/03 with regards to claims 1-3.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (USPN 5,980,487).

The examiner would first like to clarify one issue with the applicant and that is that the applicant is attempting to claim the specific elements of the syringe functionally, and not positively, therefore the examiner is only giving functional weight to the barrel, needle holder, a locating ring, a plunger, a needle and a needle shield as recited in the preamble of claim 1.

Jones et al. discloses a plunger engagement section for safety hypodermic syringe, applied in a safety hypodermic syringe having a barrel, a needle holder, a locating ring, a plunger, a needle and a needle shield, comprising the characteristics that the plunger (11) accommodated in the barrel (10) is provided with a protruding portion (72) at a front end of the engagement section (32) thereof, and the protruding portion fills a hollow space (73) at an interior of the needle holder (13) when pushing the plunger forward and performing an injection, thereby allowing more medicament to be injected, Figures 1, 2, 3, and Column 5, lines 13-19 & lines 43-55.

With regards to claim 2, wherein the protruding portion is raised and extended from a middle portion of the engagement section for corresponding with the space at the

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interior of the needle holder, can be seen in figure 2 & 3, Column 5, lines 13-19 & lines 43-55.

With regards to claim 3, wherein the protruding portion is a cylindrical body having dimensions corresponding to a diameter of the space at the interior of the needle holder, thereby filling the space when pushing the plunger forward, which can be seen in figure 2 & 3 and Column 5, lines 13-19 & lines 43-55.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (USPN 5,098,402).

The examiner would first like to clarify one issue with the applicant and that is that the applicant is attempting to claim the specific elements of the syringe functionally, and not positively, therefore the examiner is only giving functional weight to the barrel, needle holder, a locating ring, a plunger, a needle and a needle shield as recited in the preamble of claim 1.

Davis discloses a plunger engagement section for safety hypodermic syringe, applied in a safety hypodermic syringe having a barrel, a needle holder, a locating ring (76), a plunger, a needle and a needle shield, comprising the characteristics that the plunger (52) accommodated in the barrel (14) is provided with a protruding portion (78) at a front end of the engagement section (82) thereof, and the protruding portion fills a hollow space (74) at an interior of the needle holder (20) when pushing the plunger forward and performing an injection, thereby allowing more medicament to be injected, Figures 1, 3, and Column 6, lines 26-67 & Column 8, lines 7-20.

With regards to claim 2, wherein the protruding portion is raised and extended from a middle portion of the engagement section for corresponding with the space at the interior of the needle holder, can be seen in figure 2, and Column 8, lines 7-20.

With regards to claim 3, wherein the protruding portion is a cylindrical body having dimensions corresponding to a diameter of the space at the interior of the needle holder, thereby filling the space when pushing the plunger forward, which can be seen in figure 1 and Column 8, lines 7-20.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact EBC at 866-217-9197.

Matthew DeSanto
Art Unit 3763
March 19, 2006

